

## **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the following remarks.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1, 3, 5 and 7-12 are currently pending in this application. Claims 1, 5 and 10 are independent.

The Examiner had enclosed a listing of cited references in the "Notice of References Cited" sheet. However, the listing does not appear to be related to the August 9, 2007 Office Action. The Examiner is requested to clarify or confirm the correctness of this Notice.

### **II. THE REJECTIONS UNDER 35 U.S.C. §103**

Claims 1, 5 and 10 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,932,756 to Franchi ("Franchi") in view of Japanese Patent JP 4024298 ("JP '298") and further in view of Japanese Patent JP 10-292252.

Applicants respectfully submit that the present claims are patentable over the applied references for at least the following reasons.

#### **A. Cited references do not teach all claim recitations**

Independent claim 1 recites, *inter alia*:

"A belt for use on a corrugator machine in the manufacture of corrugated packaging board, said belt comprising:

an endless spiral-link base, said base defining a top surface and a bottom surface and including a plurality of metal spirals,  
each spiral defining an internal space, wherein the spirals are interconnected by a series of parallel pintles extending through the internal spaces of adjacent spirals,  
wherein the belt is a singlefacer belt." (Emphasis added)

Accordingly, one embodiment of the instant invention relates to a belt for use on a corrugator machine in the manufacture of corrugated packaging board, having an endless spiral-link base and including a plurality of metal spirals.

None of the cited references, considered either alone or in combination, teach or suggest the above identified feature of claim 1. Specifically, none of the cited references, considered either alone or in combination, disclose or suggest using an endless spiral-link base made of metal spirals in a corrugator machine in the manufacture of corrugated packaging board, as recited in claim 1.

**B. References Cannot Be Combined Because Reference Teaches Away from Their Combination**

As understood by the Applicant, Franchi relates to a continuous corrugator belt for supporting/conveying a sheet of cardboard, defined by a mat of multispiral fabric preferably made of synthetic polymer fibers.

Franchi specifically teaches that felts or conventional fabrics are relatively heavy and therefore difficult to assemble onto the machine; the weight, combined with a high friction coefficient, of such materials increases the energy consumption of the machine. (Col. 1, 37 - 44, Col. 2, 32-47). Therefore, one of Franchi's main objectives is to reduce the friction coefficient by reducing the weight of the belt and eventually reducing energy consumption.

JP'298, on the contrary, is teaching away from Franchi in that both the spiral wiry materials (2a) and the connecting wiry materials (2b) are preferably formed from a metal, and since the whole belt in JP'298 is formed of wiry materials, it is certainly going to increase the weight of the belt, thus increasing the friction coefficient and energy consumption.

Additionally, while Franchi relates to corrugator belts, JP'298 relates purely to a coated shoe press belt. There is no teaching or suggestion for use of metal spirals in Franchi.

Quite contrarily, Franchi avoids using any heavy materials for the spirals in order to avoid any weight on the belt. As to JP'252, it merely teaches a corrugating machine. Although JP'252 mentions single facer and double backer belts, there is no suggestion for using metal spiral coils, or even spiral coils for that matter. Therefore, there is no motivation for one of ordinary skill in the art to modify the teachings of Franchi in view of JP'298 and/or JP'252. Specifically, there is no motivation for a skilled artisan to use metal spirals in Franchi's belt, when the primary reference, Franchi itself teaches away from the combination.

MPEP §2145(X)(d) states:

**"It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.)" (Emphasis added)**

The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicant submits that there is nothing that would motivate a skilled worker in the art to modify the teachings of Franchi in view of JP'298 or JP'252, when Franchi lacks the very motivation to do so.

C. Impermissible hindsight reasoning and mosaic reconstruction

Applicants respectfully submit that *impermissible hindsight* reconstruction of the claimed invention using elements of the prior art is *not* allowed under 35 U.S.C. §103 (see MPEP §2142 for a discussion of impermissible hindsight).

Furthermore, MPEP §2143.01(III) states:

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)”  
(Emphasis in original)

Applicant respectfully submits that the Office Action has merely created a mosaic of features from the prior art, without either a clear motivation or a suggestion of the desirability of the combination.

Additionally, MPEP §2143.01(IV) states:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because **the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.** *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).  
(Emphasis added)

As noted above, the Office Action has merely provided references to teach individual aspects of the claimed invention in total isolation, and has not established a *prima facie* case of obvious. The Office Action has failed to provide an objective reason to *combine* the disparate and unrelated teachings of the references into the claimed combination. Therefore, Applicant submits that the combination of references is inappropriate, and requests the withdrawal of the rejections.

For at least the foregoing reasons, Applicant respectfully submits that independent claim 1 patentably distinguishes over the cited references and is therefore allowable. Since claims 5 and 10 are similar in scope to claim 1, they are also allowable.

### III. DEPENDENT CLAIMS

Since the other claims are each dependent from one of the independent claims discussed above, they are also patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

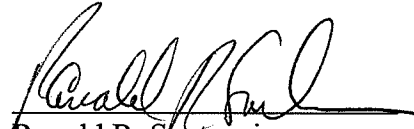
### CONCLUSION

In view of the foregoing remarks, all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By:

  
Ronald R. Santucci  
Reg. No. 28,988  
(212) 588-0800